

ATTORNEY DOCKET NO.  
073030.0134

PATENT APPLICATION  
09/658,016

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REMARKS

Claims 1-14 are pending in the present application. In view of the remarks which follow, reconsideration is respectfully requested.

Incomplete Office Action

Applicants' first Information Disclosure Statement (IDS) was filed on November 15, 2000. Applicants are enclosing a copy of an acknowledgment post card, which bears the date stamp of the PTO mailroom, and which shows that this first IDS was in fact received by the PTO.

The pending Office Action was issued almost three years after the PTO received the first IDS, but does not reflect consideration of the first IDS, and is therefore incomplete. In this regard, Applicants respectfully direct the attention of the Examiner to MPEP §609(III)(C)(2), which specifically recognizes that Applicants are not required to use Form PTO-1449. In particular, this section of the MPEP states that: "If the citations are submitted on a list other than on a form PTO-1449 or PTO/SB/08A and 08B, the examiner may write 'all considered' and his or her initials to indicate that all citations have been considered". Thus, although Applicants' first IDS did not use Form PTO-1449, the Office Action should have been accompanied by an initialed copy of the sheet which lists the documents that were cited in the first IDS.

Since the Office Action does not indicate that the Examiner considered the first IDS on the merits, the Office

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Action is incomplete. In this regard, the attention of the Examiner is respectfully directed to the provisions MPEP §609, §609(III)(B)(1) and §609(III)(C)(2), which make it clear that, when an IDS complies with the provisions of 37 C.F.R. §§1.97 and 1.98, the Examiner is required to consider the IDS before issuing the next communication on the merits, and the next communication must be accompanied by an initialed copy of the applicants' "list" of documents. Since the present Office Action did not include an initialed copy of the list from the first IDS, the Office Action is incomplete. Consequently, the Examiner's next communication on the merits will technically be the first proper communication on the merits, and should be a non-final action which is accompanied by an initialed copy of the list of documents from Applicants' first IDS.

Second Paragraph of 35 U.S.C. §112

On page 2 of the Office Action, the Examiner rejects Claims 1-14 under the second paragraph of 35 U.S.C. §112, asserting that these claims are indefinite because independent Claims 1 and 8 each include the word "different". In particular, the Examiner asserts that the word "different" is a relative term, and therefore renders the claims indefinite. This §112 rejection is respectfully traversed, for the following reasons.

First, there is no good basis for the assertion that the word "different" is a "relative" term. In this regard, the provisions of MPEP §2173.05(b) discuss various terms which the PTO considers to be "relative" terms that could potentially be

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indefinite. The word "different" does not appear among the various terms which are discussed there. The Examiner has not offered any support whatsoever for the assertion that "different" is a word which is routinely regarded by the PTO as a "relative" term.

The Examiner then goes on to assert (1) that the word "different" is not defined in the claims, and (2) that the specification does not provide a standard to measure a degree of difference or certainty. The Examiner's statement on this point uses only standard "boilerplate" language, and does not contain a single word which is specific to the context of the claims that appear in the present application. In fact, the entire §112 rejection lacks a single word of explanation as to why, in the specific context of Claims 1 and 8, the word "different" might somehow present some indefiniteness. The Examiner basically assumes that the word "different" is automatically indefinite whenever it is used in a claim, but that assumption is directly contrary to standard PTO practice.

For the foregoing reasons, it is respectfully submitted that there is no reasonable basis for the assertion that the word "different" is a relative term, and thus no basis for the assertion that independent Claims 1 and 8 are inherently indefinite because they happen to include the word "different". It is therefore respectfully submitted that Claims 1-14 are definite and comply with the second paragraph of §112, and notice to that effect is respectfully requested.

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Independent Claim 1

Claim 1 stands rejected under 35 U.S.C. §102 as anticipated by Penn U.S. Patent No. 5,848,198. This ground of rejection is respectfully traversed, for the following reasons.

The Penn patent basically appears to disclose nothing more than a software program which can process an electronic image obtained by a medical imaging technique, such as x-ray, magnetic resonant imaging (MRI), or ultrasound. It does not appear that the Penn patent contains anything which is even remotely similar to the subject matter of Claim 1. In this regard, the Office Action does not include any discussion of what is disclosed in the Penn patent, or why it might be considered to be similar to the subject matter of Claim 1. Instead, the Office Action simply extracts some language from Claim 1, and inserts parentheses containing some line and column numbers from Penn. However, even the indicated portions of Penn appear to have little or no relevance to the subject matter of Claim 1.

As one example, Claim 1 recites "a source portion identifying a data source and defining an output port through which data from the data source can be produced", and also recites "a destination portion identifying a data destination and defining an input port through which data can be supplied to the data destination". At the top of page 4, the Office Action indicates that these limitations are completely met by the teaching which appears at lines 60-67 in column 6 of the Penn patent. However, lines 60-67 in column 6 of Penn merely state that an analysis image and an original image are each in the

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form of a matrix of pixel values, and that the analysis image is analyzed and the original image is processed. Lines 60-67 in column 6 say absolutely nothing about any kind of source portion or data source from which the analysis image or the original image is obtained before being analyzed or processed. Further, lines 60-67 in column 6 say absolutely nothing about any destination portion or data destination to which the analysis image or original image is sent after being analyzed or processed. Thus, the paragraph at lines 60-67 in column 6 appears to be totally irrelevant to the specific claim limitations that the Office Action attempts to associate with this paragraph.

As another example, Claim 1 recites "information which includes a definition of control information for said control port of said one function portion". In the second paragraph on page 4, the Office Action indicates that this portion of Claim 1 is completely met by lines 37-44 in column 11 of Penn. However, lines 37-44 in column 11 merely mention a picture or image consisting of ten line segments of equal length. It is respectfully submitted that there is no way this picture could even remotely be considered to be comparable to the indicated portion of Claim 1, which includes a recitation of control information for the control port of a function portion. Thus, the text at lines 37-44 in column 11 appears to be totally irrelevant to the specific claim limitations that the Office Action attempts to associate with this text.

The line and column numbers provided for other portions of Claim 1 appear to have similar problems, but it is

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believed to be unnecessary to discuss each of them here in detail. As emphasized in MPEP §2131, anticipation under §102 requires the presence in a single prior art reference of each and every element of the claimed invention, arranged as in the claim. As evident from the foregoing discussion, Claim 1 has limitations which are not even remotely met by the specific portions of the Penn patent which the Examiner attempts to associate with these limitations. It is therefore respectfully submitted that Claim 1 is clearly not anticipated under §102 by Penn. Claim 1 is therefore believed to be allowable, and notice to that effect is respectfully requested.

Independent Claim 8

Independent Claim 8 is a Beauregard-type claim, which is similar in some respects to Claim 1. Claim 8 stands rejected under 35 U.S.C. §102, based on the same rationale used to reject Claim 1. It is respectfully submitted that Claim 8 is patentably distinct from the Penn patent, for the same basic reasons discussed above in association with Claim 1. Claim 8 is therefore believed to be allowable, and notice to that effect is respectfully requested.

Dependent Claims

Claims 2-7 and Claims 9-14 respectively depend from Claim 1 and Claim 8, and are also believed to be allowable over the art of record, for example for the same reasons discussed above with respect to Claims 1 and 8.

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Conclusion

Based on the foregoing, it is respectfully submitted that all of the pending claims are fully allowable, and favorable reconsideration of this application is therefore respectfully requested. If the Examiner believes that examination of the present application may be advanced in any way by a telephone conference, the Examiner is invited to telephone the undersigned attorney at (214) 953-6684.

Although Applicants believe that no additional fee is due, the Commissioner is hereby authorized to charge any fee required by this paper, or to credit any overpayment, to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,  
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